Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. REEVES, ROBERT A. WOLF,
and PAUL I. CHANG

Appeal No. 2003-1416
Application No. 09/819,549

ON BRIEF

Before WINTERS, TIMM, and MILLS, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 14-24, which are all the claims pending in the application.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

All the claims are rejected as unpatentable. As evidence of unpatentability, the Examiner relies upon the following prior art references:

Ray W. Gifford, Jr., *Management of Isolated Systolic Hypertension in the Elderly*, 34 J. of the Am. Geriatrics Soc'y 106 (1986) (EMBASE 969).

A New Class of Potent Antihypertensive Agents: Especially Systolic Pressure is Significantly Reduced, MMW Fortschritte Der Medizin, vol. 141, no. 47 at 8 (Nov. 25, 1999) (MEDLINE 858).[1]

Vasopeptidase-Inhibitor: Omapatrilat in Systolic Hypertension, Deutsche Apotheker Zeitung, vol. 140, no. 8, Feb. 24, 2000 at 36 (EMBASE 767).[2]

Claims 14-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EMBASE 767 or MEDLINE 858 alone or in view of EMBASE 969.

Appellants indicate that claims 14-24 stand or fall together. We select claim 14, the only independent claim, to represent the issues on appeal. Claim 14 reads as follows:

14. A method of treating isolated systolic hypertension in a human patient comprising administering to said patient an effective amount of a vasopeptidase inhibitor.

Because we agree with the Examiner's conclusion of unpatentability in view of the prior art, we affirm the Examiner's decision refusing to allow the claims. However, since our rationale

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[1]We rely upon and cite to the English translation of record.

[2]We rely upon and cite to the English translation of record.

for affirming the decision of the Examiner differs from that of the Examiner, we denominate our affirmance as involving a new ground of rejection pursuant to 37 CFR § 1.196(b). Our reasons follow.

OPINION

The sole step in method claim 14 is a step of administering an effective amount of a vasopeptidase inhibitor to a human patient. The "effective amount" is an amount effective to treat isolated systolic hypertension.

MEDLINE 858 reports on studies conducted in Atlanta in which the vasopeptidase inhibitor omapatrilat was administered to human patients. MEDLINE 858 reports that omapatrilat "presented a clear lowering of the systolic and the diastolic blood pressure over 24 h with a single dose." In fact, the reference states that "[t]he results indicated a superior blood pressure lowering effect, especially for the systolic blood pressure." The data presented indicates a lowering of between 19 and 28 mm Hg. We find that the administration of the vasopeptidase inhibitor in amounts effective to lower systolic pressure as described in MEDLINE 858 meets all the limitations of the method of claim 14. Thus, MEDLINE 858 anticipates the claimed method under 35 U.S.C. § 102(a).[3] Moreover, EMBASE 767 offers further evidence that the systolic

[3]EMBASE 767 and MEDLINE 858 *prima facie* qualify as prior art under 35 U.S.C. § 102(a) as these articles say nothing specific about inventorship. *See In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982). Appellants have not disputed the status of the references as prior art.

pressure lowering effect demonstrated by the data disclosed in MEDLINE 858 translates to an amount of omapatrilat effective to treat isolated systolic hypertension. Note the quotation of Prof. Dr. Rainer Kolloch, Biefeld: "Omapatrilat is well suited for treatment of [isolated systolic hypertension], because of its efficient effect on both systolic and diastolic pressure." (MEDLINE 767, ll. 19-20). Note that it is permissible to rely upon additional references in an anticipation rejection to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public. *In re Samour*, 571 F.2d 559, 563, 197 USPQ 1, 4-5 (CCPA 1978); *see also Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991)("To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence.").

Appellants' sole argument is that EMBASE 767 merely suggests that it may be obvious to try and use a vasopeptidase inhibitor such as omapatrilat to treat systolic hypertension and "obvious to try" is not the appropriate standard under 35 U.S.C. § 103 (Brief, pp. 3-4). According to Appellants, MEDLINE 858 does not overcome the deficiency of EMBASE 767 as it merely reports a clinical study where omapatrilat lowered systolic and diastolic blood pressure over 24 hours with a single dose (Brief, p. 4). This argument is no longer relevant, as we have found that claim 14, the representative claim, is anticipated. Due to this shift in statutory basis, we designate our affirmance as involving a new ground of rejection. *See In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 178-79 (CCPA 1979).

We need not discuss the merits of EMBASE 969 as this reference was cited as evidence of obviousness with respect to the additional limitations of claims 17-24 and those claims stand or fall with claim 14.

We conclude that the Examiner has established a *prima facie* case of unpatentability with respect to the subject matter of claims 14-24 which has not been sufficiently rebutted by Appellants.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 14-24 as unpatentable is affirmed, but we designate our affirmance as involving a new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter considered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR § 1.196(b)

SHERMAN D. WINTERS Administrative Patent Judge	)
CATHERINE TIMM Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
DEMETRA J. MILLS Administrative Patent Judge	)

CT:psb

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